

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 22

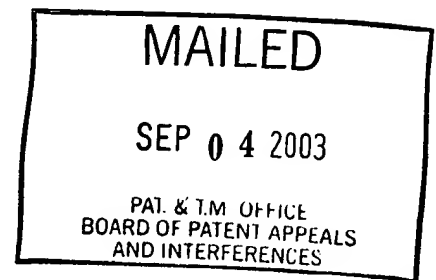
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN MELLARDO

Appeal No. 2003-1210
Application No. 09/295,212

ON BRIEF



Before GARRIS, TIMM, and POTEATE, Administrative Patent Judges.
GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1-9 which are all of the claims in the application.

The subject matter on appeal relates to a cables arrester in combination with an energized-fluid conduit comprising a plurality of cables confined within the conduit and means removably fixed to a wall surface within the conduit for holding the plurality of cables in spaced-apart disposition. This appealed subject matter is adequately illustrated by independent claim 1 which reads as follows:

Appeal No. 2003-1210
Application No. 09/295,212

1. A cables arrester, in combination with an energized-fluid conduit, comprising:

a conduit having a wall surface, the conduit for conducting an energized fluid therethrough;

a plurality of power cables confined within said conduit; and

means removably fixed to said wall surface within said conduit for holding said plurality of cables in spaced-apart disposition across said conduit.

The references relied upon by the examiner as evidence of obviousness are:

Kramer et al. (Kramer)	4,483,395	Nov. 20, 1984
Bayh, III (Bayh)	4,913,239	Apr. 3, 1990

Claims 1-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bayh in view of Kramer. According to the examiner, "it would have been obvious to one having ordinary skill in the art of cables at the time the invention was made to modify the bridging means [i.e., electrical connector means 45] of Bayh . . . to comprise the bridging means [i.e., guard device 10] as taught by Kramer because Kramer teaches that such a configuration provides protection from abrasion against the inner surfaces of the conduit (Col. 1, lines 33-36) and provides a simple and inexpensive construction that functions in a more efficient manner than any comparable device (Col[.] 3, lines 60-65)" (answer, page 5).

This rejection cannot be sustained.

We fully agree with the appellant's position that the applied prior art contains no teaching or suggestion for the above noted combination proposed by the examiner. As correctly argued by the appellant, Bayh's electrical connector means (which the examiner refers to as a "bridging means" in his above quoted obviousness conclusion) is in a completely different environment than Kramer's guard device 10 (which the examiner refers to as a "bridging means" in his obviousness conclusion). Bayh's electrical connector means 45 is disposed within tubing string 20 (e.g., see figure 1), and this tubing string is disposed within a casing string which is not shown (e.g., see lines 54-58 in column 2). As the examiner seems to appreciate, fluid is directed up through the tubing string 20 via pump 70 (e.g., see the sentence bridging columns 2 and 3). On the other hand, Kramer's guard device 10 is disposed within well casing 12 for holding drop pipe 11, electrical conductor 17 and safety rope 18 (e.g., see figure 1). Similar to the tubing string 20 of Bayh, the drop pipe 11 of Kramer carries water which is forced through this pipe via pump 15 to discharge line 16 (e.g., see the paragraph bridging columns 1 and 2).

It is apparent that Bayh's tubing string 20 corresponds to Kramer's drop pipe 11 and concomitantly that Bayh's casing string (not shown) corresponds to Kramer's well casing 12. Viewed from this perspective, an artisan with ordinary skill might have combined the applied reference teachings by providing Bayh's casing string (not shown) with a guard device of the type taught by Kramer for holding Bayh's tubing string 20 within the casing string pursuant to the manner in which the analogous drop pipe 11 of Kramer is held within his well casing 12. Certainly it is clear that, in the absence of impermissible hindsight, the artisan would not have disposed this guard device inside of Bayh's tubing string 20 in replacement of patentee's electrical connector means 45 (which is referred to by the examiner as a "bridging means"). This is because such a disposition would be analogous to using Kramer's guard device inside of his drop pipe 11, and there is simply no teaching or suggestion in Kramer (or in Bayh) of such a use.

There are other reasons for doubting that an artisan would have replaced Bayh's electrical connector means 45 with Kramer's guard device 10 as proposed by the examiner. For example, we do not perceive and the examiner does not explain how the guard device would be capable of performing the connecting function

Appeal No. 2003-1210
Application No. 09/295,212

performed by Bayh's electrical connector means. Similarly, we do not perceive and the examiner does not explain how Bayh's apparatus, if modified to include use of a guard device as proposed by the examiner, would be capable of performing the functions of


inserting and retrieving submersible pump 70, electric motor 50 and related components from a selected downhole location as desired by patentee (e.g., see lines 8-20 in column 3).

For the above stated reasons, we determine that the applied reference evidence adduced by the examiner fails to establish a prima facie case of obviousness within the meaning of 35 U.S.C. § 103. It follows that we cannot sustain the examiner's Section 103 rejection of claims 1-9 as being unpatentable over Bayh in view of Kramer.


Appeal No. 2003-1210
Application No. 09/295,212

The decision of the examiner is reversed.

REVERSED


BRADLEY R. GARRIS
Administrative Patent Judge

Catherine Timm
CATHERINE TIMM
Administrative Patent Judge


LINDA R. POTEATE
Administrative Patent Judge

BOARD OF PATENT
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BRG: hh

Appeal No. 2003-1210
Application No. 09/295,212

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